

Beiersdorf 514.1-HCL
6713-Dr Wi ar**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : SCHÖNROCK et al.
SERIAL NO. : 09/132,799
FILED : 13 August 1998
FOR : COSMETIC OR DERMATOLOGICAL PREPARATIONS COMPRISING
OLIGOPEPTIDES FOR LIGHTENING THE SKIN OF AGE MARKS
AND/OR PREVENTING TANNING OF THE SKIN, IN PARTICULAR
TANNING OF THE SKIN BY UV RADIATION
ART UNIT : 1654
EXAMINER : Michael Borin

13 January 2003

Box AF**Attn: Group Director TC 1650 – Bruce Kisliuk**

Hon. Commissioner of Patents

Washington, D.C. 20231

PETITION OF FINALITY OF REQUIREMENT OF RESTRICTION UNDER 37 CFR § 1.144

SIR:

In response to the finality of the restriction and election of species requirement issued by the examiner in Paper No. 7, dated 24 February 2000, please accept this petition to reconsider the restriction requirement (especially the election of species requirement) of Paper No. 5, dated 26 May 1999.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REQUEST FOR RECONSIDERATION

The impetus for filing this petition was the comments which were made by the examiner in the final rejection dated 8 October 2002 (Paper No. 27). Claim 21 was excluded from consideration with claims 6, 11, 12, 14-20 and 22 which were examined on the merits. The examiner wrote "In regard to election of species, during an early stage of prosecution (during a telephone conversation with Attorney S. Ryan on 04/10/99), applicant elected, without traverse, a single monomer oligopeptides species of example 4 (Ac-VVRP-NH₂; p. 37); the pending claims were examined on the merits to the extent they read on the elected

species and, broader, on monomer oligopeptides VVRP, its amide and/or N-acetyl derivative. Current claims reading on the elected species, are 6, 11-20, 22-26. Claim 21 is withdrawn from consideration as drawn to non-elected species."

As such, the applicants request that claim 21 be rejoined with claims 6, 11, 12, 14-20 and 22 for the purposes of Appeal.

Applicants did traverse the restriction/election of species requirement

The passage referred to with regard to election without traverse made above by the examiner can be found on page 4, lines 6-10 of the examiner's first office action dated 26 May 1999 (Paper No. 5).

However, as can be seen by the examiner's comments, this was a **provisional election** and was to be affirmed during the applicants' next response. As can be seen in page 5 of the applicants' response (Paper No. 6), the applicants' affirmed the election **with traverse** and gave an explanation for the reasons for the traversal.

Examiner is presumed to have made restriction requirement final

In Paper No. 7, the examiner addresses the applicants' traversal arguments and appears to reaffirm his restriction/election of species requirement although there is no formal statement that the requirement was made final.

Examiner is making a distinction between acetyl and longer alkyl chains

The species which was elected was example 4 which contained Ac-VVRP-NH₂, i.e. CH₃-C(=O)-VVRP-NH₂. As stated by the examiner above, "...the pending claims were examined on the merits to the extent they read on the elected species and, broader, on monomer oligopeptide VVRP, its amide and/or N-acetyl derivative." The R moiety of the independent claims throughout the prosecution history of the application has been a branched or unbranched, saturated or unsaturated alkyl radical having C₁-C₃₀ carbon atoms.

It is unclear why if acetyl (i.e. C₁) is considered part of the invention to be examined, why other longer chains (i.e. C₂-C₃₀) would be considered to be patentably distinct inventions. While it is possible that inventions distinguished by differing alkyl chain lengths may be patentably distinct, no reason is given why this is the case for this particular situation. MPEP 808.01(a) states that "Election of Species should not be required if the species claims are considered clearly unpatentable (obvious) over each other."

Closing

A favorable decision on this petition is respectfully requested. If any further information is needed, please feel free to contact the undersigned at the telephone number below.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Petition of Finality of Restriction Requirement under 37 CFR 1.144 (3 pages total), is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 13 January 2003

By: 

Vilma I. Fernandez

FAX RECEIVED

JAN 14 2003

GROUP 1600

FACSIMILE COVER SHEET

NORRIS MCLAUGHLIN & MARCUS, P.A.

220 East 42nd Street30th Floor

New York, New York 10017

Tel.: (212) 808-0700

Fax.: (212) 808-0844

Date: 13 January 2003**To:** Examiner Michael Borin
US Patent and Trademark Office
Tel. 703-305-4506
Fax: 703-305-3014**Subject:** USSN 09/132,799
Our Ref.: Beiersdorf 514.1**From:** Howard C. Lee**Comments:** Filing of Petition Of Finality Of Requirement Of Restriction Under 37 CFR § 1.144 (3 pgs.)

If you have any questions or need further information, please contact us.

You should receive 4 pages including this cover sheet.

The information contained in this facsimile message is intended only for the personal and confidential use of the recipient(s) named above. This message may be an attorney-client communication and as such is privileged and confidential. If the reader of this message is not the intended recipient or an agent responsible for delivering it to the intended recipient, you are hereby notified that you have received this document in error and that any review, dissemination, distribution, or copying of this message is strictly prohibited. If you have received this communication in error, please notify us immediately at the number above and discard the original message.